

## PATENT COOPERATION TREATY

NOV - 8 2005

From the INTERNATIONAL BUREAU

**PCT**

NOTIFICATION CONCERNING  
TRANSMITTAL OF COPY OF INTERNATIONAL  
PRELIMINARY REPORT ON PATENTABILITY  
(CHAPTER I OF THE PATENT COOPERATION  
TREATY)

(PCT Rule 44bis.1(c))

To:

KELLOGG, Rosemary  
Swanson & Bratschun, L.L.C.  
1745 Shea Center Drive, Suite 330  
Highlands Ranch, CO 80129  
ETATS-UNIS D'AMERIQUE

Date of mailing (*day/month/year*)

27 October 2005 (27.10.2005)

Applicant's or agent's file reference

UNI26PCT

**IMPORTANT NOTICE**

International application No.

PCT/US2004/010279

International filing date (*day/month/year*)

02 April 2004 (02.04.2004)

Priority date (*day/month/year*)

04 April 2003 (04.04.2003)

Applicant

UNIGEN PHARMACEUTICALS, INC. et al

The International Bureau transmits herewith a copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)

The International Bureau of WIPO  
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Authorized officer

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## PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY  
(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

|  |   |   |                  |
|--|---|---|------------------|
| Applicant's or agent's file reference<br>UNI26PCT  | FOR FURTHER ACTION  |   | See item 4 below |
| International application No.<br>PCT/US2004/010279   | International filing date ( <i>day/month/year</i> )<br>02 April 2004 (02.04.2004) | Priority date ( <i>day/month/year</i> )<br>04 April 2003 (04.04.2003) |                  |
| International Patent Classification (IPC) or national classification and IPC<br>A61K 35/78 |   |   |                  |
| Applicant<br>UNGEN PHARMACEUTICALS, INC.   |   |   |                  |

- This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).
- This REPORT consists of a total of 5 sheets, including this cover sheet.  
  
In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.
- This report contains indications relating to the following items:
 

|  |   |
|--|---|
| <input checked="" type="checkbox"/> Box No. I    | Basis of the report   |
| <input type="checkbox"/> Box No. II              | Priority  |
| <input type="checkbox"/> Box No. III             | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| <input type="checkbox"/> Box No. IV              | Lack of unity of invention  |
| <input checked="" type="checkbox"/> Box No. V    | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI              | Certain documents cited   |
| <input type="checkbox"/> Box No. VII             | Certain defects in the international application  |
| <input checked="" type="checkbox"/> Box No. VIII | Certain observations on the international application   |
- The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis.2).

|   |  |
|---|--|
| The International Bureau of WIPO<br>34, chemin des Colombettes<br>1211 Geneva 20, Switzerland<br><br>Facsimile No. +41 22 740 14 35 | Date of issuance of this report<br>14 October 2005 (14.10.2005)                      |
|   | Authorized officer<br><br>Agnes Wittmann-Regis<br><br>Telephone No. +41 22 338 89 70 |

# PATENT COOPERATION TREA

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:  
ROSEMARY KELLOGG  
SWANSON & BRATSCHUN, L.L.C.  
1745 SHEA CENTER DRIVE, SUITE 330  
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13 SEP 2004

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## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing  
(day/month/year)

10 SEP 2004

### FOR FURTHER ACTION

See paragraph 2 below

Applicant's or agent's file reference

UN26PCT

International application No.

International filing date (day/month/year)

Priority date (day/month/year)

PCT/US04/10279

02 April 2004 (02.04.2004)

04 April 2003 (04.04.2003)

International Patent Classification (IPC) or both national classification and IPC

IPC(7): A61K 35/78 and US Cl.: 424/757

Applicant

UNIGEN PHARMACEUTICALS, INC.

### 1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 6.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

### 3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US

Mail Stop PCT, Attn: ISA/US  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Facsimile No. (703) 305-3230

Form PCT/ISA/237 (cover sheet) (January 2004)

Authorized officer

Randall Winston

Telephone No. 571-272-0972

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US04/10279

Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This opinion has been established on the basis of a translation from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
- a. type of material
- ☐ a sequence listing
- ☐ table(s) related to the sequence listing
- b. format of material
- ☐ in written format
- ☐ in computer readable form
- c. time of filing/furnishing
- ☐ contained in international application as filed.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US04/10279

**Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**1. Statement**

|                               |             |     |
|-------------------------------|-------------|-----|
| Novelty (N)                   | Claims 1-45 | YES |
|                               | Claims NONE | NO  |
| Inventive step (IS)           | Claims NONE | YES |
|                               | Claims 1-45 | NO  |
| Industrial applicability (IA) | Claims 1-45 | YES |
|                               | Claims NONE | NO  |

**2. Citations and explanations:**

Claims 1-45 lack inventive step under PCT Article 33(3) as being obvious over Pierre et al (US 5,773,014) in view of Marfat (US 6,391,872). Pierre et al. teach (see, e.g., column 4 lines 17-23) the claimed method and composition comprising of administering to a host in need thereof a pharmaceutical composition comprising a Free-B-ring Flavonoid (i.e. baicalin and/or baicalein) for tyrosinase inhibitory activity. Pierre et al. do not teach administering a flavan (i.e. catechin) in various effective amounts and in what form for the same purpose. Marfat teaches (see, e.g. column 1, lines 12-16, column 1 lines 63-66 and column 10-15) the administering of a flavan (i.e. catechin) for tyrosinase inhibitory activity. The adjustment of conventional working conditions (i.e. in various effective amounts and/or in what form), is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Claims 1-45 meet the criteria set out in PCT Article 33(4), because one of ordinary skill in the art can create a composition and/or method for tyrosinase inhibitory activity.

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US04/10279

**Box No. VIII** Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the questions whether the claims are fully supported by the description, are made:

Claim 18 under PCT Article 6 is rendered indefinite. Claim 18 is not dependent on any previous claims. Correction is required.